

**REMARKS**

Applicants respectfully request favorable reconsideration of this application, as amended.

At the outset, Applicants would like to thank Examiners Ramdhanie and Griffin for the courtesies extended to Applicants' representative during the interview conducted on October 30.

Claims 10, 14 and 15 were objected to due to informalities. In response, Claim 10 has been amended to correct the typographical error, and Claim 14 has been canceled without prejudice. Claims 1 and 3–20 were rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as being indefinite, and have been amended accordingly. No new matter has been added, and Applicants respectfully submit that the objections and rejections have been overcome.

Claims 1 and 3–20 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over Claims 1 and 2 of U.S. Patent No. 7,013,197. In response, a terminal disclaimer has been filed concurrently herewith, and Applicants respectfully submit that the rejection has been overcome.

Claims 1, 3–7, 9–18 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malin (U.S. 2004/0115101) in view of Helwig (U.S. 6,129,428). Applicants note that because Claims 8 and 19 were not specifically addressed by the Office Action's obviousness rejections (i.e., Paragraph 15, Pages 5–9), these claims are presumed to contain allowable subject matter.

In the interests of receiving an expedited Notice of Allowance, and without acceding to the rejections, Claim 1 has been amended to recite certain features of the claimed invention more perspicuously. Additionally, Claim 8 has been amended for clarity, Claims 15–20 have been canceled without prejudice and Claims 21–27 have been added. Support for these amendments may be found, for example, in the Specification at Pages 4–6; in FIGS. 1–4; etc. No new matter has been added, and Applicants respectfully submit that none of the cited references, taken either singly or in combination, teaches or suggests all of the features recited by the pending claims.

Malin and Helwig disclose air-conditioned storage cabinets. As depicted in FIGS. 5a and 5b, Malin's climate controlled cabinet includes a climate controlled chamber 2 in which three stationary storage towers 650 and a handling device 620 are located. Handling device 620 transports objects, through auxiliary door 15, to and from transfer position 110 located on

"external object conveyor system 100." *See, e.g.*, Paragraphs 0045, 46, 80–83, etc. Similarly, as depicted in FIG. 1, Helwig's climatic test cabinet 1 includes a storage volume 2 in which object storage device 7 and transporting device 11 are located. Transporting device 11 has a plate-like carrier or shovel 50 which transfers an object carrier 8, through window 6, to and from a "feeding and removal transporter (not depicted)." *See, e.g.*, Col. 4:66 to Col. 5:42, etc.

Neither Malin nor Helwig teaches or suggests a buffer specimen storage device, disposed outside the utilization space of the cabinet, that includes a plurality of storage locations, as recited by Claim 1, or a means for storing specimens that is disposed outside the walls of the cabinet, as recited by Claim 21. Instead, Malin merely discloses that his "external object conveyor system 100 can e.g. comprise a transfer position 110 (e.g. of the type of temperature adaptation device 40), as well as an automatic transport system for the objects" (Paragraph 0083). While Malin fails to disclose any further details of his external object conveyor system, the Office Action alleges that Malin's conveyor must "inherently" include a plurality of storage locations.<sup>1</sup> Applicants disagree. In order for such a feature to be an inherent characteristic of Malin's conveyor, the plurality of storage locations must "necessarily flow from the teachings of the applied art." *See, Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Further, the "fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *See, In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). *See, e.g.*, MPEP § 2112. Applicants respectfully submit that the Office Action has failed carry this burden, because there is nothing within Malin's disclosure to suggest that his external conveyor system 100 inherently includes storage locations. Helwig is similarly deficient – there is nothing within Helwig's disclosure to suggest that his feeding and removal transporter inherently includes storage locations. Consequently, neither Malin nor Helwig explicitly or implicitly disclose the claimed features.

Furthermore, neither Malin nor Helwig teaches or suggests an outer transport device, disposed outside the utilization space, to transport specimen slides to and from the buffer specimen storage device and to establish a transport connection with the transfer opening such that a specimen slide is transported between the buffer specimen storage device, the inner

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<sup>1</sup> *See, Office Action at Paragraph 3, Page 2* ("The plurality of storage locations must be inherent because Malin discloses that the automatic conveyor system is for 'objects' – emphasis on the plurality of the

transport device, and the specimen storage device, as recited by Claim 1, or a second means for transporting specimen slides, disposed outside the walls, to convey specimen slides between the second means for storing specimen slides and the transfer opening, the first and second means for transporting specimen slides cooperating together to exchange specimen slides within the transfer opening, as recited by Claim 21. At most, both Malin and Helwig teach that objects may be transferred between the internal and external transporters at transfer positions that are located outside the cabinets, such as transfer position 110 located on the upper surface of Malin's external object conveyor system 100. Consequently, neither Malin nor Helwig disclose the claimed features.

Accordingly, Applicant respectfully submits that Claims 1 and 21 are allowable over the cited references. Furthermore, Claims 3-7, 9-18 and 20 depending from Claim 1, and Claims 22-27, depending from Claim 21, are also allowable, at least for the reasons discussed above.

Moreover, Applicants respectfully submit that many dependent claims are independently allowable over the cited references. For example, neither Malin nor Helwig disclose an external conveyor or transport system that includes a vertically-movable lift and a horizontally-movable shifting unit, as recited by Claims 6 and 26; neither reference discloses a specimen transfer location that is located between the outer and the inner transport devices in the area of the transfer opening, as recited by Claim 7; neither reference discloses a plurality of transfer openings by which a plurality of specimen storage devices are loaded by a plurality of inner transport devices, in which the outer transport device has an operative connection to all transfer openings, as recited by Claim 8; neither reference discloses a wall that has a plurality of transfer openings through which the specimen slides are exchanged, as recited by Claim 27; etc.

In view of the foregoing amendment and remarks presented herein, Applicants respectfully submit that this application is in condition for allowance and should now be passed to issue.

A Notice of Allowance is respectfully solicited.

If any extension of time is required in connection with the filing of this paper and has not been requested separately, such extension is hereby requested.

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objects. Based on the reasonable interpretation of this disclosure it would be essential that the automatic conveyor system contain a plurality of storage locations").

The Director is hereby authorized to charge any fees and to credit any overpayments that may be required by this paper under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account No. 50-2036.

Respectfully submitted,

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